

REMARKS

In the July 21, 2005 Office Action, the Examiner noted that claims 1-47 were pending in the application; rejected claims 1, 4, 6, 7, 10, 12, 13, 16, 18, 19, 22, 24, 25, 28, 30-32, 35, 37-40 and 45-47 under 35 USC § 102(a); and rejected claims 2, 3, 5, 8, 9, 11, 14, 15, 17, 20, 21, 23, 26, 27, 29, 33, 34, 36 and 41-44 under 35 USC § 103. U.S. Patents 6,112,208 to Ikegami; 6,349,372 to Benveniste; 5,951,623 to Reynar et al. (References A, B and E, respectively, in the May 22, 2003 Office Action); and 6,721,753 to Kataoka et al. (no citation found) were used in rejecting the claims. Claims 1-47 remain in the case. The Examiner's rejections are traversed below.

Primary Reference is not Prior Art

U.S. Patent No. 6,721,753 was issued April 13, 2004 to Masahiro Kataoka and Takashi Tsubokura who are the inventors of the subject application which was filed on February 13, 2002. 35 U.S.C. 102(a) states, "A person shall be entitled to a patent unless - (a) **the invention was known or used by others** in this country, or **patented** or described in a printed publication in this or a foreign country, **before the invention thereof by the applicant for patent**" (emphasis added). Since the date of Kataoka '753 is after the filing date of the application and the inventors are the same, Kataoka '753 is not prior art under 35 U.S.C. § 102(a). Further, it is noted that it is not prior art under 35 U.S.C. § 102(e) which requires "a patent granted on an application for patent **by another**".

Since all of the rejections rely on Kataoka '753 as the primary reference, withdrawal of the rejections and another non-final Office Action or a Notice of Allowance is respectfully requested.

Rejections under 35 U.S.C. § 102

It will be assumed for sake of argument, but without an admission of fact, that the published international application, WO 99/21092, which according to Kataoka '753 was published on April 29, 1999 based on the international application corresponding to the U.S. application from which Kataoka '753 issued, has substantially the same disclosure as Kataoka '753.

As now recited in each of the independent claims, a compressed file is obtained by "compressing each of the sections based on the conversion table created therefor using a corresponding one of a plurality of different compression parameters" (e.g., claim 1, lines 10-11).

This feature of the invention is illustrated in Fig. 9 and described in paragraph [0065] on pages 21-22 of the Substitute Specification filed February 13, 2002, for example. In the third paragraph on page 3 of the Office Action, it was asserted that the compressing operation recited in claim 1 was disclosed by Figs. 4 and 5 of Kataoka '753. However, as is clear from Fig. 6, only a single compression parameter is used in the method taught by Kataoka '753 and there is no suggestion in Figs. 4 and 5, or the description thereof in column 7, of using more than one compression parameter, where a different compression parameter is used for each section. Since the same portion of Kataoka '753 was cited in rejecting the similarly recited feature in the other independent claims, Kataoka '753 (and presumably WO 99/21092) does not anticipate independent claims 1, 7, 13, 19, 25, 32, 39, 40 and 47 or claims 4, 6, 10, 12, 16, 18, 22, 24, 28, 30, 31, 35, 37, 38, 45 and 46 which depend therefrom.

Rejections under 35 U.S.C. § 103

In items 5-7 on pages 7-13 of the Office Action, claims 2, 3, 5, 8, 9, 11, 14, 15, 17, 20, 21, 23, 26, 27, 29, 33, 34, 36 and 41-44 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kataoka '753 in view of Reynar et al., Benveniste or Ikegami. However, nothing was cited or has been found in any of these references suggesting modification of Kataoka '753 to use different compression parameters in the manner recited in the independent claims. Therefore, it is submitted that all of the claims patentably distinguish over any combination of these four references.

Consideration of Reference Submitted May 26, 2005

An Information Disclosure Statement was filed on May 26, 2005 with the Request for Continued Examination, submitting a copy of an article by Tomohiko Uematsu. Submitted herewith is a copy of the Information Disclosure Statement. Return of Form PTO -1449, with an indication that the article by Tomohiko Uematsu has been considered, is respectfully requested.

Summary

It is submitted that the references cited by the Examiner, taken individually or in combination, do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-47 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 10/073,245

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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